



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Takaomi TOIHARA

Group Art Unit: 1775

Application No.: 10/091,537

Examiner: A. Turner

Filed: March 7, 2002

Docket No.: 112172

For: HARD MULTILAYER COATING, HARD MULTILAYER COATED TOOL
INCLUDING THE HARD MULTILAYER COATING AND METHOD OF FORMING
THE HARD MULTILAYER COATING

RESPONSE TO RESTRICTION REQUIREMENT

Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

In reply to the Restriction Requirement mailed March 11, 2003, Applicant
provisionally elects Group I, claims 1-4, drawn to a coating. This election is made with
traverse.

The Restriction Requirement is traversed because rejoinder will eventually be required.
Where product and process claims are presented in the same application, Applicant may be
called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP
§821.04. However, in the case of an elected product claim, rejoinder will be permitted when a
product claim is found allowable and the withdrawn process claim depends from or otherwise
includes all the limitations of an allowed product claim. Id.

In the present application, the method claim of Group III includes all of the limitations
of, and specifically depends from, the product of Group I. Since the method claim of Group III
includes the limitations of the product claims of Group I, the method claim must be rejoined

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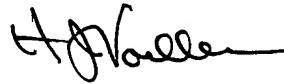
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with the product claims once the product claims are allowed. Thus, to streamline prosecution and avoid delay, the Restriction Requirement should be withdrawn to permit concurrent examination of all of the pending claims. Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement.

Furthermore, it is respectfully submitted that the subject matter of all groups is sufficiently related that a thorough search for the subject matter of the elected would encompass a search for the subject matter of the remaining groups. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which is stated that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added). It is respectfully submitted that this policy should apply in the present application to avoid unnecessary delay and expense to Applicant and duplicative examination by the U.S. Patent and Trademark Office.

In view of the foregoing, it is respectfully submitted that claims 1-8 can be examined without undue burden on the Examiner. Accordingly, it is respectfully requested that the Restriction Requirement be withdrawn.

Respectfully submitted,



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JAO:HJV/tea

Date: March 26, 2003

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